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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,792	06/22/2001	Tobias Meyer	0459-0570P	9673
2292	7590	09/07/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			WESSENDORF, TERESA D	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/787,792		MEYER, TOBIAS	
	<b>Examiner</b>		<b>Art Unit</b>	
	T. D. Wessendorf		1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,11-14,23-25 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,11-14,23-25 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Status of Claims***

Claims 7-10, 15-22 and 26-46 have been cancelled.

Claims 1-6, 11-14, 23-25 and 47-49 are under examination.

***Specification***

The objection to the abstract no longer applies with the new abstract of record.

***Response to Arguments***

In view of applicants' statement that Figs. 4 A-D was filed with the as-filed specification, the objection no longer applies.

***Claim Rejections - 35 USC § 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In view of the amendments to claim 4 and applicants' arguments, the rejection of the above claims under this statute no longer applies.

Claims 1-6, 11-14, 23-25 and 47-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while

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being enabling for GFP as the detectable group and isoforms of CaMKII  $\alpha$  and  $\beta$ , does not reasonably provide enablement for a first and second heterologous protein conjugates, fragments of the protein and any type of cell for reasons advanced in the last Office action.

### ***Response to Arguments***

Applicant argues that the type of cell is not relevant for the purposes of the present invention. the types of detectable groups other than GFP may be used. The unknown protein is simply one aspect of the second conjugate. It need not be, and has never been argued to only be, CaMKII  $\alpha/\beta$ . Those of skill in the art fully understand this. In page 11, lines 2-14, the known protein may simply preferably be a protein kinase C isoform. Further, the fragments, such as C1 and C2 domains are disclosed.

In response, it is not controverted that the fragments disclosed are only the C1 and C2 domains. However, there is no other fragment or detectable group or translocatable protein has been enabled in the specification. The broad claimed method encompasses numerous variables for which the enabling disclosure drawn to specific e.g., fragments or single GFP would not suffice.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 11-14, 23-25 and 47-49 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants' disclosure for reasons advanced in the last Office action.

#### ***Response to Arguments***

Applicant argues that the named Applicant for purposes of "inventorship" including conception and reduction to practice of the invention was Tobias Meyer. The use of the word "we" commonly appears in specification and can refer to others involved with the research but who, for various reasons, do not qualify as inventors. Based upon the above, Applicant respectfully submits that the Examiner's rejection is improper and should be withdrawn.

In reply, applicant's mere statement does not suffice, especially as to the various reasons why those involved in the research are not inventors. A declaration indicating that "we" refers to the non-inventors, and are not involved in conception and reduction to practice is required to obviate the rejection.

No claim is allowed.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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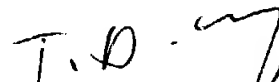
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571) 272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
T. D. Wessendorf  
Primary Examiner  
Art Unit 1639

Tdw  
September 1, 2004